REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed April 9, 2004. In the Office Action, the Examiner notes that claims 1-13, 16-18, 21-24 and 29-32 are pending of which claims 1-13, 16-18, 21-24 and 29-32 are rejected. Claims 25-28 have been withdrawn. Claims 17 and 30-32 have been cancelled.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under provision of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

THE REJECTIONS

35 U.S.C. §103

The Examiner has rejected claims 1-9, 11-13, 16-18, 21-24 and 29-32 under 35 U.S.C. §103(a) as being unpatentable over Hendricks et al. (U.S. Patent No. 6,539,548, hereinafter "Hendricks") in view of Alonso et al. (U.S. Patent No. 6,184,873, hereinafter "Alonso") and further in view of Defreese et al. (U.S. Patent No. 6,493,876, hereinafter "Defreese"). The Applicants respectfully traverse the rejection.

Applicants' amended independent claim 1 recites:

> "A method for targeting programming according to subscriber preferences, comprising:
>
> propagating, via a forward application transport channel (FATC), a plurality of video streams representing respective pages of an interactive program guide (IPG), each IPG page depicting programming associated with a respective pair of channel groups and time slots;
>
> polling a plurality of terminals for the trend data;

receiving, via a back channel, subscriber selections associated with at least one IPG page;
determining trend data associated with accumulated subscriber selections; and
adapting at least one IPG page in response to said determined trend data." (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). The combination of Hendricks and Alonso fails to teach Applicants' invention as a whole.

Hendricks discloses an Operations Center that allows for the organizing and packaging of television programs for transmission in a television delivery system (see Hendricks, col. 3, lines 12-16). A Computer Assisting Packaging (CAP) System retrieves viewer data, and assimilates the data into program packaging, via retrieval of raw data from the set-top terminals, and then filtering and presenting that data. Each headend compiles the viewer data, and then sends it verbatim to the Operations center. Menu creation, both automatically and manually, is one of the major CAP functions that involves the incorporation of the raw data. An automated software procedure analyzes the data and, using certain heuristics, creates the menus. (See Hendricks, col. 16, lines 13-40). In addition, Hendricks teaches that as a network controller, the cable headend monitors poll-back responses from the set top terminals. The poll-back cycle occurs frequently enough to allow the network controller to maintain account and billing information and to monitor authorized channel access, which is not the same as trend data. (See Hendricks, col. 10, lines 25-36).

Nowhere in Hendricks is there any teaching or suggestion of the Applicant's invention, which discloses "polling a plurality of terminals for trend data" and "adapting at least one IPG page in response to said determined trend data." Support for the Applicants' invention may be found in the Applicants' specification where "the head-end

sends a request to the terminal for the collected trend data" and "[i]n response, the terminal reports the collected data back to the head-end." (See Application, page 23, lines 10-13).

Furthermore, Alonso fails to bridge the substantial gap as between Hendricks and Applicants invention. Specifically, the Alonso reference merely discloses a method of accessing information from a computer network, such as a TCP/IP network, using a cable television system or a video on demand system. (See Alonso, col. 1, lines 64-67). Alonso uses the back channel to allow set top terminals to send requests for audiovisual programming or world wide web. (See Alonso, col. 4, lines 29-37). Nowhere in Alonso is there any teaching or suggestion of "polling a plurality of terminals for trend data" and "adapting at least one IPG page in response to said determined trend data."

Even if the two references could somehow be operably combined (and Applicants submit that they cannot be operably combined) the combination would merely provide an Operations Center for organizing and packaging television programs for transmission in a television delivery system capable of allowing subscribers to send requests via a back channel on the set top terminals for audiovisual programming or world wide web that can also poll set top terminals for accounting and billing information and monitor authorized channel access. Polling for accounting and billing (i.e. administrative) information is NOT the same as polling for trend data such as, selections made by the viewers, requests for particular programming, or demographic information. The combination of the two references does not teach or suggest the Applicant's claim of "polling a plurality of terminals for trend data" and "adapting at least on IPG page in response to said determined trend data." Therefore, the combination of Hendricks and Alonso fails to teach or suggest Applicants' invention as a whole.

Furthermore, the Examiner has inadvertently failed to particularly point out what is taught by the Defreese reference, as well as to establish a *prima facie* case of obviousness using the Defreese reference. 37 C.F.R. §1.106 states that:

> "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. . . The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added)

Further, the Federal Circuit Court of Appeals has held that:

> "The 'prima facie' case notion . . ., seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument." *In re Oetiker*. 977 F.2d 1443, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992)(Plager, J., concurring) (emphasis added).

The Examiner has not met the requirements of 37 C.F.R. §1.106, for rejecting claims 1-9, 11-13, 16-18, 21-24, and 29-32, since the Examiner has failed to clearly and specifically state how the Defreese reference contributes to establishing a *prima facie* case of obviousness. As such, the Examiner has failed to give the Applicant a fair opportunity to meet the rejection of claim 1, in view of Defreese, with evidence and argument. Therefore, the Applicants respectfully request that the Examiner particularly point out the specific passage in the Defreese reference that the Examiner believes teaches the features of the Applicants' invention.

Notwithstanding, Defreese discloses a system and method for providing a full service cable television system. Defreese discloses "Reverse Data Channels that carry IP datagram messages from the set top terminal to equipment within the cable headend. These messages can relate to network management, external device data services, program/service control and activation, or general matters." (See Defreese, col. 4, lines 1-6). Defreese fails to teach "polling a plurality of terminals for trend data" and "adapting at least on IPG page in response to said determined trend data." Therefore, the combination of Hendricks, Alonso, and Defreese fails to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 11-13, 16, 18, 21-24 and 29 depend, either directly or indirectly, from independent claim 1 and recite additional features thereof. As such, and at least for the same reasons as discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

Claim 10

The Examiner has rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Hendricks et al., Alonso, and Defreese, as applied to claim 1, and in further view of Gordon et al. (U.S. Patent No. 6,621,870, hereinafter "Gordon"). Applicants respectfully traverse the rejection.

Claim 10 depends upon claim 1 and recites additional features thereof. In particular, claim 1 recites in part:

> "A method for targeting programming according to subscriber preferences, comprising:
> propagating, via a forward application transport channel (FATC), a plurality of video streams representing respective pages of an interactive program guide (IPG), each IPG page depicting programming associated with a respective pair of channel groups and time slots;
> polling a plurality of terminals for the trend data;
> receiving, via a back channel, subscriber selections associated with at least one IPG page;
> determining trend data associated with accumulated subscriber selections; and
> adapting at least one IPG page in response to said determined trend data." (emphasis added).

As discussed above the combination of Hendricks, Alonso and further in view of Defreese fails to teach or suggest Applicants' invention as a whole. Therefore, at least for the same reasons set forth above with respect to claim 1, Applicants submit that claim 10 is not unpatentable over Hendricks and Alonso in view of Defreese.

Applicants further submit that Gordon fails to bridge the substantial gap between the combined teachings of Hendricks, Alonso, and DeFreese, and the Applicants' invention. In particular, Gordon merely teaches a method and apparatus for compressing a plurality of video sequences that can be used for efficiently encoding and transmitting a user interface such as an interactive program guide. (See Gordon, col. 4, lines 48-51). Gordon teaches using a programming filter icon within the interactive program guide. (See Gordon, col. 14, lines 34-40). Nowhere in Gordon does it teach or suggest Applicants' invention of "polling a plurality of terminals for trend data" and "adapting at least on IPG page in response to said determined trend data."

Therefore, Applicants respectfully submit that claim 10 is patentable over Hendricks, Alonso in view of DeFreese and further in view of Gordon, and the Examiner's rejection should be withdrawn.

CONCLUSION

Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg, Esq. or Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

7/8/04

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